REMARKS

Claims 1-13 are pending in this application. The following remarks are in response to the Office Action mailed June 28, 2004 ("the Office Action").

Claim Rejections

Claims 1-13 are rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,428,470, to Labriola II, in view of U.S. Pat. No. 6,308,231, to Galecki et al. This rejection, as best understood, is respectfully traversed.

The Office Action alleges (essentially in its entirety):

> Labriola II discloses system for controlling motor comprising module processor in communication with central processor and feedback circuitry in communication with module processor, see fig 1 #50, #56 and col 6 lines 4-65. Labriola II lacks disclosing central processor in communication with encoder. Galecki et al discloses encoder in communication with central processor, see fig 6 #56 and #52 as well as col 12 lines 50-55. It would have been obvious to one of ordinary skill in the art to combine the control system of Labriola II with the encoder with central processor of Galecki et al for improved control.

Applicants respectfully submit that the above-quoted paragraph is insufficient as an Office Action. At best, only claim 1 is addressed. None of the other pending claims (2-13) is even mentioned, and they all comprise elements that are not in claim 1 and not mentioned in the Office Action.

In any event, the § 103 rejection of claim 1 is improper, for at least several reasons.

First, the Office Action fails to particularly point put those parts of Labriola that are relied upon to reject claim 1. "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." MPEP § 706(c)(2). Applicants respectfully submit that the Office Action has not satisfied this requirement. The Office Action asserts that Labriola discloses "system for controlling motor comprising module processor in communication with central processor and feedback circuitry in communication with module processor" at "fig 1 #50, #56 and col 6 lines 4-65." Applicants are unable to determine what element of Labriola the Patent Office is identifying as a "module processor," what element is alleged to be a "central processor," and what elements are alleged to be "feedback circuitry." Simply referring to two elements of FIG. 1

(50 and 56) and essentially all of column 6 does not convey the required information. Clarification is respectfully requested.

Second, the Office Action fails to particularly point out those parts of Galecki that are relied upon to reject claim 1. The Office Action alleges that Galecki "discloses encoder in communication with central processor, see fig 6 #56 and #52 as well as col 12 lines 50-55." Galecki has a FIG. 6A and a FIG. 6B (no figure is labeled "FIG. 6"). Neither FIG. 6A nor FIG. 6B has an element labeled "56." Indeed, there appears to be no element 56 in Galecki at all (in any of the figures). Further, element 52 is merely a "control-side terminal." The Patent Office has thus provided only vague and partially inaccurate indications as to what precise elements in Galecki are supposed to, in combination with Labriola, render claim 1 unpatentable. Clarification is respectfully requested.

Third, there is no proper motivation provided for combining Labriola with Galecki. Labriola is directed to a modular automatic analyzer. An electric motor is incidentally mentioned, but Labriola's system is not in the electric motor field (see, e.g., abstract, and FIG. 1). Galecki is directed to a programmable analog I/O circuit for use in an industrial control system. Galecki is directed to a particular generic control circuit (see, e.g., FIG. 3A), and is not in the electric motor field specifically. Thus, neither Labriola nor Galecki is analogous art to the present invention.

In light of the fact that non-analogous references were improperly cited in the Office Action, the Patent Office is respectfully requested to identify the specific field to which Applicants' invention allegedly belongs (i.e., to identify analogous art) and to restrict cited references to that field. See MPEP § 2141.01(a) (Heading): "To rely on a reference under 35 U.S.C. 103, it must be analogous prior art." See also MPEP § 2141.01(a), "Analogy in the Electrical Arts."

The ground asserted in the Office Action for combining alleged elements of Labriola with alleged elements of Galecki is that it "would have been obvious to one of ordinary skill in the art to combine the control system of Labriola II with the encoder with central processor of Galecki et al for. improved control." But this alleged motivation to combine is improper for at least three reasons: it uses Applicants' claim as a roadmap, the combination doesn't result in Applicants' invention, and there could be no reasonable expectation of success.

As is well-known, it is improper for the Patent Office to use hindsight as a guide to combining references. In order for Labriola properly to be combined with Galecki, there must be some teaching or motivation in the prior art to make that specific combination. See, e.g., MPEP § 706.02(j): "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure."

An unsupported allegation that combining Galecki with Labriola would result in "improved control" is not enough. Why would one skilled in the art aware of Labriola decide to choose Galecki if they wanted to "improve control"? Why does "control" in Labriola need to be improved? How does the system taught by Galecki improve control of some aspect of the system of Labriola? What particular aspect of Labriola's system has its control improved by Galecki? And what particular aspect of Galecki improves control for Labriola's system? Clearly, vague assertions of "improvement" do not provide a proper motivation to combine these two particular references. More details must be provided by the Patent Office to support its § 103 rejection of claim 1.

Moreover, combining Labriola with Galecki doesn't appear to result in an operable system, much less result in Applicants' invention. Labriola teaches an automatic analyzer; Galecki teaches a control circuit. The Office Action doesn't explain how those two systems are to be combined, or how the resulting combination would work. Obviously the "central processor" of Labriola would differ from that of Galecki (assuming each discloses some type of central processor) – one would not expect to just take Galecki's central processor and plug it into Labriola's system. And neither would have a central processor as described in claim 1.

In any event, there is no reason to believe that such a combination would result in Applicants' invention. Indeed, there's no reason to believe that such a combination would result in anything desirable. So there is no reasonable expectation of success.

Most improper about the Office Action, though, is that it completely ignores claims 2-13 and the limitations therein. For example, claim 2 requires a system as in claim 1, wherein the encoder is an electronic device that provides rotor and stator positional information to the central processor. Claim 7 requires a system as in claim 1, wherein the central processor comprises a

field programmable gate array. No mention is made of these limitations. Claim 9 is an independent method claim not even alluded to in the Office Action.

Applicants expended a substantial amount of time and money to ensure that each claim filed with this application was proper, and expended even more time and money responding to this Office Action. Since the effort has been made and the Patent Office fees have been paid, Applicants are entitled to have each separate claim properly and carefully examined.

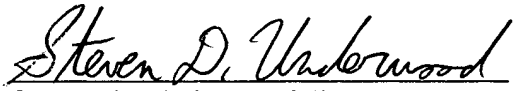
As the Patent Office knows, even if claim 1 had actually been obvious, that in itself would provide no grounds for rejecting claims 2-13. Those claims must be separately analyzed.

All claim rejections are believed to have been overcome by this Response. All pending claims therefore are believed to be allowable, and a prompt Notice of Allowance would be appreciated.

No fee is believed due with this Response. However, if any fee is due, please charge that fee to Deposit Account No. 50-0310.

Respectfully submitted,

Dated: August 26, 2004



Steven D. Underwood, Esq.
Registration No. 47,205
MORGAN, LEWIS & BOCKIUS LLP
101 Park Avenue
New York, NY 10178-0060
(212) 309-6000